

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed June 10, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112**

Claims 5, 11, and 15 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 5 and 15 have been rejected for use of the phrase “HP’s e-speak”. In response to the rejection, Applicant has removed the term “HP’s” from both claims. Despite this change, Applicant has left the term “e-speak” in the claims given that that term is believed to be necessary to describe the particular platform that the Applicant would like to claim. Therefore, the term “e-speak” is not being used in a trademark sense (i.e., to identify source), but rather in a descriptive sense to describe the type of platform being recited. Given that there is no generic term for the e-speak platform that would specifically identify the platform, Applicant has no alternative to use of the term “e-speak.”

As a further point, Applicant notes that the term “e-speak” is commonly used in a descriptive sense instead of a trademark sense. This fact is evident when one conducts an Internet search for the term “e-speak.” In conducting a recent search, Applicant found many instances of the term “e-speak,” and none of those instances were accompanied with a trademark symbol. Indeed, the term “e-speak” is even used by the Hewlett-Packard Company without such a trademark symbol.

Finally, Applicant notes that Applicant's use of the term "e-speak" does not render the scope of claims 5 and 15 uncertain. As noted above, a person having ordinary skill in the art can readily determine what "e-speak" refers to with a simple Internet search. Moreover, the Examiner was able to formulate a prior art rejection of claims 5 and 15 despite the supposed uncertainty.

Given the above, Applicant believes that Applicant's use of the term "e-speak" is both proper and necessary to adequately describe the claimed platform with particularity. Applicant respectfully submits that claims 5 and 15 define the invention in the manner required by 35 U.S.C. § 112. Accordingly, it is respectfully requested that the rejections to these claims be withdrawn.

Claim 11 has been rejected due to ambiguity as to antecedent basis for the term "computer." This ambiguity has been remedied with an amendment to claim 11. Applicant therefore respectfully requests that the rejection to claim 11 also be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-4, 6, 7, 9-14, 16, 17, and 19 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Vange, et al. ("Vange," U.S. Publication No. 2002/0007404). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the claimed invention is represented in

the Vange reference. Applicant discusses the Vange disclosure and Applicant's claims in the following.

#### **A. The Vange Reference**

As is described by Vange, caching is used to store copies of "pages or page elements" in caches located closer to the clients that are requesting the pages. Vange, paragraph 0009. Therefore, when a "web page" can be served out of a cache, the page is returned more quickly to a user. Id.

Because of the above-described advantages of caching web pages, Vange describes a system and method that can be used to achieve such caching. As is described by Vange (paragraph 0022, emphasis added):

The present invention involves systems and methods for providing improved performance in network communications through the use of a caching web server located at the client-side "edge" of a network environment. This means that the web server implementing the cache in accordance with the present invention is logically proximate to the client application *generating requests for web pages*.

In view of the above, it appears clear that Vange's system is focused on caching web pages, and not on caching online services.

#### **B. Applicant's Claims**

Vange does not anticipate each and every limitation of Applicant's claims 1-4, 6, 7, 9-14, 16, 17, and 19. Applicant discusses the various claim groups separately in the following.

## **1. Claims 1-4, 6-7, and 9**

Applicant's claim 1 provides as follows (emphasis added):

1. A method for *caching an online service* on a local point of presence, the online service being hosted on a remote host computer, the method comprising:

receiving a request, at a local point of presence, to access an online service;

determining if the requested online service is locally stored on the local point of presence;

in response to determining that the requested online service is not locally stored, *downloading the requested online service* from a remote host computer hosting the requested online service; and

*storing the downloaded online service on the local point of presence.*

As can be appreciated from the above text, claim 1 is directed to a method for caching an "online service". As is noted above, however, Vange does not disclose caching of such a "service" and instead appears to be focused on caching "web pages," as is now conventional in the art. Given this distinction, Vange cannot anticipate Applicant's claim 1 under 35 U.S.C. §102, which requires anticipation of each and every explicit claim limitation.

Applicant notes that the distinction between caching web pages and online services is significant. Specifically, caching online services involves the downloading and storing of executable programs that facilitate the service, so that the service can be run locally, out of a POP. As is described by Applicant (page 8, lines 23-30):

The host server 112 may be an Internet host that provides one or more online services, such as, by way of example, an electronic business

card service, an electronic travel reservation service, an electronic retail service, and the like, on the Internet. In one embodiment, the host server 112 conforms to HP's e-speak specifications, and thus, provides one or more e-services. For example, the electronic business card service, the electronic reservation service, and the electronic retail service is developed utilizing HP's SFS and Service Engine. Thus, host server 112 can host one or more e-services that may, in whole or in part, be downloaded to, and executed on the service caching POP 104.

Such downloading, storing, and running of an online service therefore constitutes more than simply downloading and storing web page HTML.

In view of the above, Applicant respectfully submits that Vange's teachings are inadequate to anticipate claim 1, and the claims that depend therefrom. Accordingly, Applicant respectfully requests that the rejection to claims 1-4, 6-7, and 9 be withdrawn.

## 2. Claims 10-14, 16-17, and 19

Independent claim 10 provides as follows (emphasis added):

10. A computer-readable storage medium having stored thereon computer instructions that, when executed by a computer, cause the computer to:

receive a request to access an online service;

determine if the requested online service is locally stored on a local point of presence;

in response to determining that the requested online service is not locally stored, *download the requested online service* from a remote host computer hosting the requested online service to the local point of presence; and

*store the downloaded online service* on the local point of presence.

From the above text, it can be appreciated that claim 10 requires instructions that cause a computer to download and store an “online service”. As is noted above in relation to claim 1, Vange does not disclose downloading or storing of online services. Vange therefore does not anticipate each and every explicit limitation of claim 10 and, accordingly, Applicant respectfully requests that the rejection of claim 10 and its dependents be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims 5 and 15**

Claims 5 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Vange in view of Wray (U.S. Publication No. 2001/0023482). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1 and 10, Vange does not teach caching of “online services”. In that Wray does not remedy this deficiency of the Vange reference, Applicant respectfully submits that claims 5 and 15, which depend from claims 1 and 10, respectively, are allowable over the Vange/Wray combination for at least the same reasons that claims 1 and 10 are allowable over Vange.

#### **B. Rejection of Claims 8 and 18**

Claims 8 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Vange in view of Edwards, et al. (“Edwards,” U.S. Pat. No. 6,591,288). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1 and 10, Vange does not teach caching of “online services”. In that Edwards does not remedy this deficiency

of the Vange reference, Applicant respectfully submits that claims 8 and 18, which depend from claims 1 and 10, respectively, are allowable over the Vange/Edwards combination for at least the same reasons that claims 1 and 10 are allowable over Vange.

### **C. Rejection of Claim 20**

Claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Vange in view of Burns, et al. (“Burns”, U.S. Pat. No. 6,275,496). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1 and 10, Vange does not teach caching of “online services”. Given that claim 20 recites “means for downloading the requested online service from a remote host computer hosting the requested online service” and “means for storing the downloaded online service on the local point of presence”, it follows that Vange likewise fails to teach all of the limitations of claim 20. Given that Burns does not remedy these deficiencies of the Vange reference, Applicant respectfully submits that claim 20 is allowable over the Vange/Burns combination.

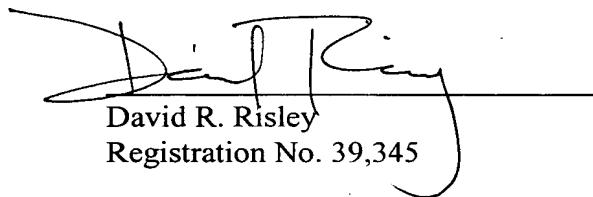
### **IV. New Claims**

As is identified above, claims 21-37 have been added into the application through this response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

8-18-04

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Signature